UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,279	03/29/2001	Kazutoyo Maehiro	P23939	3873

7055	7590	04/19/2005	EXAMINER

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EXAMINER
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ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/821,279	MAEHIRO, KAZUTOYO
	Examiner	Art Unit	
	Asad M. Nawaz	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 November 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 March 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date. _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Amendment

1.   This action is responsive to the amendment filed on 11/1/04. Claims 1, 4, 7, 10, and 13 have been amended. Claims 16-20 have been added.

2.   On page 10, paragraph 3 of the "Remarks" filed by the applicant, applicant argues that switching between different interfaces cannot occur in the previously applied references. However, it is not clear from nor is it presented in the claim language how the switching operation is done or what it actually is. This. argument and other limitations have been further addressed in this Office Action.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudjonsson (US Provisional Application 60/133,401) and in further view of Manber et al. (US Patent No. 6,651,086).

As to claim 1, Gudjonsson teaches a client system in a message exchanging system comprising a plurality of client systems and at least one server system connected together via a communications network, the server system authenticating each user of said plurality of client systems and accumulating and distributing messages, said plurality

of client systems exchanging messages via said server system, the client system

comprising: (pg 2, lines 1-10, 19-25; pg 3, lines 1-3; pg 4, lines 1-4; pg 5, lines 4-5, 15-

22; pg 6, lines 1-7; pg 15, lines 2-6; pg 17, lines 23-24)

a first message exchanging system that enables one-to-one message exchanges

with a first client system of said plurality of client systems via a first interface; (pg 6,

lines 12-18; pg 7, lines 1-4, 15-20; pg 12, lines 22-26; pg 13, lines 1-2; pg33, lines 16-25;

pg 34, lines 1-15; pg 39, lines 16-22; pg 40, lines 1-8)

a second message exchanging system that enables simultaneous message

exchanges with at least one additional second client systems of said plurality of client

systems via a second interface; (pg 35, lines 17-23; pg 36, lines 1-2; pg 44, lines 15-20;

pg 73, lines 1-24; pg 79, lines 15-22)

and message exchange switching system that switches between the first interface

of said first message exchanging system and the second interface of said second message

exchanging system, in response to an action by a user of the client system to enable

message exchanges with said first and at least one additional client systems. (pg 44, lines

15-20; pg 54, lines 9-18)

With respect to the limitation, "when said client system receives a message from

said second client system while said first message exchanging system is exchanging

messages with said first client system" in claim 1, Gudjonsson does not explicitly

indicate a second client system contacting the client system. Manber et al., however,

teaches a system and a method for connecting two or more individuals to an Internet

conversation based on their mutual interests where the user is presented with an option to

start or join a conversation. If the user desires to join a conversation, the user must send a

comment to the "owner" of the conversation. The owner then, based on the user's comment, would either allow the user to enter the chat or disallow them. This system can be employed from two to many users. (Abstract; Fig 2; col 2, lines 1-13; col 4, lines 10-20; col 5, lines 25-35)

With respect to claim 1, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Manber et al. into those of Gudjonsson to make the system simpler and easier for the novice user of instant messaging/chat applications. The combination of the two references would allow a user to follow a more definitive path to join a chat session.

As to claim 2, Gudjonsson teaches a client system according to claim 1, wherein said message exchange switching system sets in said server system an environment for allowing said second message exchanging system to exchange messages when said message exchange switching system switches from said first message exchanging system to said second message exchange switching system. (pg 44, lines 15-20; pg 54, lines 9-18; pg 73, lines 1-24; pg 81, lines 13-18; pg 82, lines 1-19)

As to claim 3, Gudjonsson teaches a client system according to claim 2, wherein said first message exchanging system displays exchanged transmitted and received messages in one display screen in the order of transmissions and receptions. (pg 14, lines 21-22; pg 40, lines 5-6; pg 43, lines 1-10; pg 56, lines 12-23)

Claims 10-12 are rejected for essentially being a computer-readable recording medium for the system of claims 1-3.

Claims 13-15 are rejected for essentially being a program product for the system of claims 1-3.

As to claim 4, Gudjonsson teaches a message exchanging method for a client system in a message exchanging system comprising a plurality of client systems and at least one server system connected together via a communications network, the server system authenticating each user of said plurality of client systems and accumulating and distributing messages, said plurality of client systems exchanging messages via said server system, the method comprising: (pg 2, lines 1-10, 19-25; pg 3, lines 1-3; pg 4, lines 1-4; pg 5, lines 4-5, 15-22; pg 6, lines 1-7; pg 15, lines 2-6; pg 17, lines 23-24)

Enabling, via a first interface, one-to-one message exchanges with a first client system of said plurality of client systems; (pg 6, lines 12-18; pg 7, lines 1-4, 15-20; pg 12, lines 22-26; pg 13, lines 1-2; pg33, lines 16-25; pg 34, lines 1-15; pg 39, lines 16-22; pg 40, lines 1-8)

· Enabling, via a second interface, simultaneous message exchanges with at least one other second client system of said plurality of client systems; (pg 35, lines 17-23; pg 36, lines 1-2; pg 44, lines 15-20; pg 73, lines 1-24; pg 79, lines 15-22)

and switching between the first interface of one-to-one message exchanging and the second interface of simultaneous message exchanging to enable message, in response to an action by a user of the client system while exchanges with said first and second client systems. (pg 44, lines 15-20; pg 54, lines 9-18)

With respect to the limitation, "when said client system receives a message from said second client system while said first message exchanging system is exchanging messages with said first client system" in claim 1, Gudjonsson does not explicitly indicate a second client system contacting the client system. Manber et al., however, teaches a system and a method for connecting two or more individuals to an Internet

conversation based on their mutual interests where the user is presented with an option to start or join a conversation. If the user desires to join a conversation, the user must send a comment to the "owner" of the conversation. The owner then, based on the user's comment, would either allow the user to enter the chat or disallow them. This system can be employed from two to many users. (Abstract; Fig 2; col 2, lines 1-13; col 4, lines 10-20; col 5, lines 25-35)

With respect to claim 4, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Manber et al. into those of Gudjonsson to make the system simpler and easier for the novice user of instant messaging/chat applications. The combination of the two references would allow a user to follow a more definitive path to join a chat session.

As to claim 5, Gudjonsson teaches a message exchanging method for a client system according to claim 4, wherein said switching sets in said server system an environment for allowing exchanging of messages when said switching switches. (pg 44, lines 15-20; pg 54, lines 9-18; pg 73, lines 1-24; pg 81, lines 13-18; pg 82, lines 1-19)

As to claim 6, Gudjonsson teaches a message exchanging method for a client system according to claim 5, further comprising displaying exchanged transmitted and received messages in one display screen in the order of transmissions and receptions. (pg 14, lines 21-22; pg 40, lines 5-6; pg 43, lines 1-10; pg 56, lines 12-23)

Claims 7-9 are rejected for essentially being the message exchanging system in which the system of claims 4-6 resides.

As to claims 16, 17, 18, 19, and 20, Gudjonsson teaches a button display that displays a button in response to interruption of the one-to-one message exchanging by the second client system.(page 14)

5.   Applicant's amendment necessitated the grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP $ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M Nawaz whose telephone number is (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

AMN

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER